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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,194

10/16/2003

Vilho Nissinen

3397-94DV4

7128

7590

03/19/2007

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EXAMINER

HALPERN, MARK

ART UNIT

PAPER NUMBER

1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/687,194

Applicant(s)

NISSINEN ET AL.

Examiner

Mark Halpern

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-64 is/are pending in the application.
- 4a) Of the above claim(s) 63 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 3/7/2007.

Claim 62 is amended.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claim 62 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 62 is a non-statutory claim since it includes the **USE** and the **METHOD OF MAKING** of recycled calcium carbonate. Claim 62 part "A use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, comprising: treating the paper, board, or nonwoven product with the recycled calcium carbonate," pertains to the use of recycled calcium carbonate. Claim 62 part "the recycled calcium carbonate being prepared by calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product; reacting the lime with water to form calcium hydroxide; and reacting the calcium hydroxide with carbon dioxide to form the recycled calcium carbonate." pertains to the method of making recycled calcium carbonate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

- 3) Claim 62 is rejected under 35 U.S.C. 102(b) as being anticipated by Sohara (5,759,258). Sohara discloses the forming of calcium carbonate from residues of deinking of wastepaper process, as shown in Figure 1. The formed recycled calcium carbonate also known as precipitated calcium carbonate (PCC) is used for treatment of paper, for example, to provide high brightness to the paper as disclosed in Example I (cols. 6-7).

Response to Amendment

- 4) Claim 62 rejection under 35 U.S.C. 101, is withdrawn in view of amended claim.
- 5) Claim 62 rejection under 35 U.S.C. 112, second paragraph, is withdrawn in view of amended claim.
- 6) Applicant's arguments filed 3/7/2007, have been fully considered but they are not persuasive.

Applicant traverses the restriction of previous Office Action.

As indicated in the previous Office Action, newly submitted claims 63, 64, are directed to an invention that is independent or distinct from the invention originally

claimed for the following reasons: Claim 63 recites a method of treating a paper. Claim 64 recites a method of making recycled calcium carbonate.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 63, 64, are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is deemed proper and is therefore made FINAL.

In regard to claim 62, Applicant alleges that the cited prior art, Sahara, does not disclose "calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product".

Claim 62 part "the recycled calcium carbonate being prepared by calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product" pertains to the method of making the recycled calcium carbonate and does not pertain to the use of the recycled calcium carbonate. Claims 62 part "A use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, comprising: treating the paper, board, or nonwoven product with the recycled calcium carbonate," pertains to the use of recycled calcium carbonate. Sahara discloses recycled calcium carbonate, also known as precipitated calcium carbonate (PCC), is used for treatment of paper, for example, to provide high brightness to the paper as disclosed in Example I, regardless as to how the recycled calcium carbonate is formed.

Conclusion

7) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.



Mark Halpern
Primary Examiner
Art Unit 1731